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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,174	12/27/2000	Liisa Kanniainen	557.302US01	4935

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EXAMINER	
WORJLOH, JALATEE	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/749,174	KANNIAINEN, LIISA	
	Examiner	Art Unit	
	Jalatee Worjloh	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-63* is/are pending in the application.

4a) Of the above claim(s) *41-50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40 and 51-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed on December 28, 2005, in which claim 21 was amended.

Response to Arguments

2. Applicant's arguments, see pages 1-3, filed December 28, 2005, with respect to the rejection(s) of the independent claim(s) under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Publication No. 2002/0013774 to Morimoto and US Publication No. 2002/0046187 to Vargas et al.

3. Claims 1-40 and 51-63 have been examined.

Claim Rejections - 35 USC § 112

4. Claims 1, 21, and 60 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 21, and 60 recite, "wherein the trusted server is an impartial intermediary and does not operate on behalf of either the merchant system or the buyer system"; however, the specification does not provide support for this limitation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-15, 21-27, 33-40, 51, 52, and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2002/0013774 to Morimoto in view of US Publication No. 2002/0046187 to Vargas et al.

Referring to claim 1, Morimoto discloses a trusted server (i.e. "broker-agent server"), the trusted server prepares a contract for a transaction between a merchant system and a buyer system, sends the prepared contract to the buyer system for acceptance by a user of the buyer system (see paragraph [0012]) and a charging engine for calculating a charge to be paid to the merchant system by the user (see claim 29, lines 12-16). As per the step of returning the accepted contract to the merchant system wherein the merchant system initiates the transaction based upon the accepted contract, Morimoto teaches this process (see paragraph [0013]). Specially, Morimoto teaches the process of conducting an auction, in which the preferred providers are provided with an accepted contract. The merchant that offers the best price and benefits is bind to the accepted contract and initiates the transaction. Morimoto does not expressly disclose wherein the trusted server is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system. Vargas et al. disclose the trusted server (host computer system) is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system (see claim 1 – the host computer operates on behalf of an

investment banking firm not the user or merchant). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Morimoto to include a trusted server this is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system. One of ordinary skill in the art would have been motivated to do this because it improves the current management systems by including negotiation, facilitation and consummation of transactions (see Vargas et al. paragraph [0005]).

Referring to claims 2 and 37, Morimoto discloses the trusted server identifies whether the merchant system has modified the contract (see paragraph [0014]).

Referring to claim 3, Morimoto discloses the trusted server finalizes the contract (see paragraph [0065]).

Referring to claims 4 and 33, Morimoto discloses the merchant system comprises a web server (ser paragraph [0039]).

Referring to claims 5 and 24, Morimoto discloses an interface between the merchant system and the buyer system, the interface including a Wireless Application Protocol (WAP) server for the buyer system supporting WAP connection (see paragraph [0066]). Notice, Morimoto discloses utilizing wireless devices for the negotiation process, which suggests that the interface may be a WAP server for WAP connection.

Referring to claims 6-8 and 34-36, Morimoto discloses the charge is for a product and the product comprises at least a portion of a content source, wherein the content source comprises a document; wherein the content source comprises a multimedia object (i.e. "CD") (see paragraph [0042]).

Referring to claims 9-11 and 38-40, Morimoto discloses the buyer system comprises a mobile terminal; wherein the mobile terminal comprises a web-enabled mobile phone; wherein the buyer system comprises a computer system coupled to the Internet (see paragraph [0066]).

Referring to claims 12 and 23, Morimoto discloses a World Wide Web interface, the interface interfacing the buyer system and the merchant system, i.e. "e-commerce site", (see paragraph [0038]).

Referring to claims 13 and 25, Morimoto discloses the trusted server receives payment from the buyer system, confirms payment by the buyer system and prevents non-repudiation of the transaction by the buyer system (see paragraph [0054]).

Referring to claims 14 and 26, Morimoto discloses the charging engine receives charging data representing billing information from the merchant system and transfers a charge amount to the buyer system for payment by the buyer system (see paragraph [0063]).

Referring to claims 15 and 27, Morimoto discloses the charging engine converts the received charging data into another form ready to be transferred to the buyer system (see paragraph [0059]).

Referring to claim 21, Morimoto discloses at least one buyer system for operation by a user desiring to purchase a product, at least one merchant system configured for providing a user the product and sending charging data indicative of a payment amount in consideration for providing the product (see paragraph [0041] & [0042]) and at least one payment system including a trusted server (i.e. "broker-agent server") and charging engine, for handling the negotiation of a contract for a transaction between the merchant system and the buyer system concerning the product, the trusted server being adapted to prepare the contract (see paragraphs

[0012] & [0013]) and facilitate execution of the contract for the transaction between the merchant system and the buyer system (see paragraph [0065]), and receive and confirm payment from the buyer system to disallow repudiation of the transaction by the buyer system (see paragraph [0047] and [0054]) and the charging engine being adapted to receive and process the charging data for the payment (see claim 29, lines 12-16). Morimoto does not expressly disclose wherein the trusted server is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system. Vargas et al. disclose the trusted server (host computer system) is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system (see claim 1 – the host computer operates on behalf of an investment banking firm not the user or merchant). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Morimoto to include a trusted server this is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system. One of ordinary skill in the art would have been motivated to do this because it improves the current management systems by including negotiation, facilitation and consummation of transactions (see Vargas et al. paragraph [0005]).

Referring to claim 22, Morimoto discloses at least one buyer system for operation by a user desiring to purchase a product, at least one merchant system configured for providing a user the product (see paragraph [0041] & [0042]) and at least one payment system including a trusted server (i.e. "broker-agent server"), wherein the payment system handles the negotiation of a contract for a transaction between the merchant system and the buyer system concerning the product, and the trusted server being prepares the contract for the transaction between the

merchant system and he buyer system, sends the prepared contract to the buyer system for acceptance by a user of the buyers system (see paragraph [0012]) and a charging engine for calculating a charge to be paid to the merchant system by the user (see claim 29, lines 12-16). As per the step of returning the accepted contract to the merchant system wherein the merchant system initiates the transaction based upon the accepted contract, Morimoto teaches this process (see paragraph [0013]). Specially, Morimoto teaches the process of conducting an auction, in which the preferred providers are provided with an accepted contract. The merchant that offers the best price and benefits is bind to the accepted contract and initiates the transaction. Morimoto does not expressly disclose wherein the trusted server is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system. Vargas et al. disclose the trusted server (host computer system) is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system (see claim 1 – the host computer operates on behalf of an investment banking firm not the user or merchant). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Morimoto to include a trusted server this is an impartial intermediary and does not operate on behalf of ether the merchant system or the buyer system. One of ordinary skill in the art would have been motivated to do this because it improves the current management systems by including negotiation, facilitation and consummation of transactions (see Vargas et al. paragraph [0005]).

Referring to claim 51, Morimoto discloses charging data in response to a single event (i.e. after searching for a better price) occurring in accordance with the transaction (see claim 29, lines 12-16).

Referring to claim 52, Morimoto discloses charging data in response to multiple events (i.e. detecting an action, sending and agreeing to the contract and searching for a better price) occurring in accordance with the transaction (see claim 29).

As per claims 60 and 61, see claim 1 rejection above.

Referring to claims 62 and 63, Morimoto discloses a trusted server (see claim 60 above). Morimoto does not expressly disclose the server validating a buyer signature associated with the accepted contract or managing modification of contract terms. However, the examiner notes that Morimoto system is capable of validation and management. Further, "the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

7. Claims 16-19 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto and Vargas et al. as applied to claims 14 and 22 respectively above, and further in view of US Publication No. 2003/0078862 to Kojima et al.

Referring to claims 16 and 28, Morimoto discloses a charging engine (see claims 14 and 22 above). Morimoto does not expressly disclose the trusted server receives payment form the buyer system based upon the charge amount and sent to the buyer system, confirms payment by the buyer system and signals to the merchant system that payment has been made. Kojima et al. disclose the trusted server receives payment form the buyer system based upon the charge amount and sent to the buyer system, confirms payment by the buyer system and signals to the merchant system that payment has been made (see paragraph [0008]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Morimoto to include the trusted server receives payment form the buyer

system based upon the charge amount and sent to the buyer system, confirms payment by the buyer system and signals to the merchant system that payment has been made. One of ordinary skill in the art would have been motivated to do because it provides an indication that the merchant will receive payments for the service provided.

Referring to claims 17-19 and 29-31, Morimoto discloses a trusted server (see claims 1 and 22 above). Morimoto does not expressly disclose the trusted server provides authentication for the transaction to the buyer system, the authentication for the transaction comprises authentication of the product; the transaction comprises authentication of the merchant system. Kojima et al. disclose the trusted server provides authentication for the transaction to the buyer system and the merchant system (see paragraph [0123]) and authentication for the transaction comprises authentication of the product (see paragraph [0100]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Morimoto to include the trusted server provides authentication for the transaction to the buyer system, the authentication for the transaction comprises authentication of the product; the transaction comprises authentication of the merchant system. One of ordinary skill in the art would have been motivated to do this because it provides security; thus preventing fraudulent activities.

8. Claims 20 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto and Vargas et al. as applied to claims 1 and 21 above, and further in view of US Publication No. 2002/0107785 to Melchior et al.

Morimoto discloses a buyer system, financial system and merchant system (see claim 1 above). Morimoto does not expressly disclose a financial compensation system, the financial

compensation system providing financial transaction support to the buyer system and the merchant system for the transaction. Melchior et al. expressly disclose a financial compensation system, the financial compensation system providing financial transaction support to the buyer system and the merchant system for the transaction (see paragraph [0009]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Morimoto to include expressly disclose a financial compensation system, the financial compensation system providing financial transaction support to the buyer system and the merchant system for the transaction. One of ordinary skill in the art would have been motivated to do this because it provides sufficient customer service to the buyer and merchant.

9. Claims 53-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto and Vargas et al. as applied to claim 21 above, and further in view of US Patent No. 6064987 to Walker et al.

Morimoto discloses a charging engine (see claim 21 above). Morimoto does not expressly disclose the charging engine processes the charging data to cause the payment to be made in multiple increments. Walker et al. disclose the charging engine processes the charging data to cause the payment to be made in multiple increments (see col. 11, lines 57-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Morimoto to include the charging engine processes the charging data to cause the payment to be made in multiple increments. One of ordinary skill in the art would have been motivated to do this because it provides faster means for data transmission.

Referring to claim 54, Morimoto discloses a charging engine (see claim 21 above). Morimoto does not expressly disclose multiple increments respectively correspond to multiple events, each of the multiple events occurring in accordance with the transaction. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the system. The charging engine processes the charging data in multiple increments regardless of events. Thus, this descriptive material will not distinguish the claimed invention from the prior art in term of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983): in re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to process the charging data to cause the payment to be made in multiple increments regardless of the events because the multiple events does not functionally relate to charging engine in the system.

Referring to claims 55 and 59, Morimoto discloses the buyer system is adapted to terminate (i.e. "reject") at least a portion of the multiple events and cause the charging system to cease processing of the charging data and wherein the charging system terminates further buying of the merchant offering in response to a command received from the buyer system (see paragraph [0052]).

Referring to claims 56-58, Morimoto discloses terminating further buying of the merchant offerings after processing the charging data (see [0052]). Although Morimoto does not explicitly teach the buyer/merchant/charging system is adapted to cease further buying of the merchant offerings after the charging system has processed the charging data for other of the merchant offerings. This is an inherent step; that is, after processing the data "further buying" is

automatically ceased for each transaction. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Morimoto to include the buyer/merchant/charging system is adapted to cease further buying of the merchant offerings after the charging system has processed the charging data for other of the merchant offerings. One of ordinary skill in the art would have been motivated to do this because it eliminates fraud.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jalatee Worjloh
Patent Examiner
Art Unit 3621

March 7, 2006